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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212861
Party	Defendant Bacardi & Company Limited
Correspondence Address	JANICE HOUSEY SYMBUS LAW GROUP PO BOX 11085 MC LEAN, VA 22102-7985 UNITED STATES jhousey@symbus.com
Submission	Motion to Dismiss - Rule 12(b)
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Date	02/21/2014
Attachments	91212861 LIVE TRUE BACO Motion to Dismiss 2-21-14.pdf(69237 bytes)

	:	
Fairmont Holdings, Inc.	:	
Opposer,	:	
	:	
v.	:	
	:	Opposition No. 91212861
	:	
Bacardi & Company Limited	:	Mark: DEWAR'S LIVE TRUE
Applicant.	:	
	:	

Applicant, Bacardi & Company Limited ("Applicant" or "Bacardi") moves to dismiss those claims of the Amended Notice of Opposition that rely upon Section 2(a) (false association) of the Lanham Act on the grounds that the Amended Notice of Opposition fails to states a claim under Section 2(a). Applicant further seeks to strike certain pleadings from the Amended Notice of Opposition on the grounds that are immaterial to the present proceeding and beyond the scope of the present proceeding. In addition, Applicant requests that the Trademark Trial and Appeal Board ("Board") suspend the proceedings pending disposition of this motion.

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not the subject of the present proceeding), and paragraph 12(c) be stricken from the Amended Notice of Opposition.

ARGUMENT

This case concerns a dispute regarding Applicant's application to register the mark DEWAR'S LIVE TRUE for "alcoholic beverages except beer." Opposer objects to registration of the mark and alleges two grounds including Section 2(a).¹

The pleading requirements for a Notice of Opposition claim require a statement that (1) sets forth the elements of the claim plainly and succinctly and (2) provides sufficient detail to give the registrant a clear idea of petitioner's complaint and the legal basis for recovery. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985). The Notice of Opposition in this case does not satisfy the pleading requirements because it fails to plead all the essential elements of claims under §2(a). Moreover, it fails to allege the underlying facts necessary to support any of these claims.

I. Opposer Has Failed to Allege the Essential Elements of a § 2(a) Claim or Support the Same.

Opposer asserts in Paragraph 12b of the Notice of Opposition that registration of Applicant's mark "would falsely suggest a connection with Opposer." Section 2(a) of the Lanham Act prohibits registration of a mark that

Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place

¹ Although it disputes the substance of Opposer's Section 2(d) Claim; Applicant is not challenging the sufficiency of the pleadings in this motion.

other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501 (9) or title 19) enters into force with respect to the United States.

15 U.S.C. § 1052(a).

The Board has developed precise pleading rules for claims arising under §2(a) of the Lanham Act. In order to plead a legally sufficient claim, Opposer must allege (1) that the challenged mark is the same as or a close approximation of Opposer's previously used name, identity, or persona; (2) that Opposer's mark would be recognized as such; (3) that Applicant is not connected with Opposer or the goods that Opposer provides under its registered mark; and (4) that Opposer's name, identity, or persona is sufficiently famous with respect to the relevant goods and/or services, so that the relevant public will assume that Applicant's goods and/or services are connected with Opposer. *Petróleos Mexicanos V. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.* 228 USPQ 752, 754 (TTAB 1985); *Canovas v. Venezia*, 220 USPQ 660, 661-62 (TTAB 1983). The lack of a proper pleading of the Section 2(a) claim is more perplexing in that the Interlocutory Attorney, George Pologeorgis, not only explained the pleading requirements to Opposer's Counsel during the Discovery Conference of January 9, 2014, he also provided a lengthy analysis of the same in the Board's Order dated January 22, 2014.

In addition, the pleading must allege that Opposer's name, identity, or persona achieved the required level of fame before the Applicant either filed for or began using the mark. The level of fame must be sufficient that Opposer's mark pointed solely and unmistakably to Opposer as of those dates. *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d

1894, 1899 (TTAB 1992); *The Board of Trustees of the University of Alabama v. BAMA — Werke Curt Baumann*, 231 USPQ 408, 410 (TTAB 1986).

The Notice of Opposition in this case fails to allege any of the elements necessary for pleading a §2(a) claim. It does not allege that Applicant is not connected with Opposer or the goods and services Opposer provides under its mark. It does not allege that the mark in question functioned as Opposer's name, identity, or persona before Applicant filed or began using the mark. More importantly, it does not allege that the mark solely and unmistakably points to Opposer — and did so prior to Applicant's first use of or application to register the mark. In fact, the pleading does not allege that Opposer's mark is famous.

In addition to pleading the essential elements of a §2(a) claim, Opposer must allege facts, which if proven, would establish each of those elements. "Mere parroting of the requisite elements of a Section 2(a) false suggestion of a connection claim without sufficient factual support therefor is insufficient to meet the pleading requirements." *McDonnell Douglas Corp.* at 48 ("To establish a claim of the suggestion of false connection under Section 2(a), [plaintiff] must allege, and prove, a connection with it as an organization and not merely the use of confusingly similar marks.")

The pleading does not provide any factual support for Opposer's allegations with respect to its §2(a) claim. Paragraph 12 of the Notice of Opposition contains the only allegations related to a §2(a) claim. This paragraph contains only legal conclusions and other suppositions and fails to provide a single fact upon which Opposer's §2(a) claim could be based.

Ownership of a mark by itself does not demonstrate that the mark serves as Opposer's name, identity, or persona, that the mark is solely and unmistakably associated with Opposer, or that the mark is sufficiently famous to support a claim under §2(a).

Accordingly, Opposer's claims under §2(a) should be dismissed.

II. Applicant's Other Application Is Not Relevant to the Subject Proceeding and All Allegations Referencing Such Application Should Be Stricken.

Opposer has sought to include another application filed by Applicant into the subject opposition. However, no application can be the subject of an opposition until the same is published for opposition. Applicant has been compelled to file the subject Motion to Strike to ensure that this proceeding—including discovery and the eventual testimony period—is properly limited to the registrability of the subject application. Absent the granting of this Motion, Applicant will be unduly burdened with respect to irrelevant issues. Further, allowing the specified sections to stand is potentially prejudicial to Applicant.

It is clear that the specified allegations, even if proven, would have no effect on the outcome of this proceeding and therefore, the same should be stricken. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). In *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973) the Board struck an affirmative defense attacking the validity of plaintiff's pleaded registration since such an allegation is only proper in a specific format (i.e., a counterclaim petition to cancel). Similarly, in the instant case any issues relating to any other trademark application need to be raised in a specific manner (i.e., in a Notice of Opposition filed after such application is published for opposition) and the same is wholly immaterial to the matter at hand.

CONCLUSION

WHEREFORE, Applicant hereby requests that the Board:

- (1) Dismiss Opposer's §2 (a) claim;

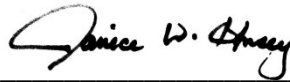
(2) Strike paragraph 8, paragraphs 9, 10 and 12(d) (to the extent that the same relate solely to a trademark application not the subject of the present proceeding), and paragraph 12(c) of Opposer's Amended Notice of Opposition.

In light of the fact that Opposer has already had an opportunity to amend its Notice of Opposition (and in fact, had the benefit of a TTAB Interlocutory Attorney's explicit instructions regarding a properly pled Notice of Opposition), Applicant respectfully requests that no further leave to amend be granted and the opposition proceed.

Upon the determination of the subject Motion, Applicant requests that a new date be set by which it can answer the remaining allegations in Opposer's Amended Notice of Opposition and re-file its counterclaim for cancellation.

Respectfully submitted,

Bacardi & Company Limited



Janice W. Housey
Counsel for Applicant

Date: February 21, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of February 2014, a true and correct copy of the foregoing APPLICANT'S MOTION TO DISMISS is being sent by email to:

kim@kkolbacklaw.com

Kim Kolback
Law Offices of Kimberly Kolback
1395 Brickell Ave., Suite 800
Miami, FL 33131

A handwritten signature in black ink, reading "Janice W. Housey". The signature is written in a cursive, flowing style.

Janice W. Housey